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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,249	10/15/2001	Giorgio Attardo	PHARMA-123	9696

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EXAMINER

MELLER, MICHAEL V

ART UNIT PAPER NUMBER

1654

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,249

Applicant(s)

ATTARDO ET AL.

Examiner

Michael V. Meller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 and 51-73 is/are pending in the application.
- 4a) Of the above claim(s) 1-38, 40-49, 51-59 and 61-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 25/7/2002
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In view of the Brief filed on 10/27/2004, PROSECUTION IS HEREBY REOPENED. The reasons for the office action are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The set of claims in the brief are incorrect. The correct set of claims is in the amendment filed 11/3/2003, since the after final was not entered by the examiner.

Election/Restrictions

Applicant's election with traverse of Group IV, claim 39 and the species of compound 21 on page 21 of the specification (claim 60) in Paper No. 11 is noted. The traversal is on the ground(s) that the methods of using the compound and the

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compound will encompass the same search. This is not found persuasive because as stated in the restriction requirement, the compounds can be used in materially distinct processes and applicant is reminded of the extensive literature search which is not co-extensive.

The structure of claim 39 is so broad and it encompasses many different compounds. The structure is simply too broad to search. Applicants elected the compound of structure 21 on page 21 of the specification. The core structure of that elected compound was searched and that is what is examined in this application. To include the other structures encompassed by claim 39 is a search which is a serious burden on the examiner.

Applicant argues that the scope of what was to be examined was not clear. It was very clear and a chemical structure was even drawn out for applicant's use. What applicant finds to be not clear is simply not understood. Is applicant suggesting that a chemical structure is not clear? How else could the examiner have made this clearer to applicant? The core structure (on page 3 of the last office action) is what the examination of this application is limited to. The claims have now been amended to delete the elected subject matter (the core structure as noted). Applicant is required to reinsert the elected subject matter (the chemical core structure presented in the last office action).

This application contains claims 1-38 and 40-49, 51-59, 61-73 drawn to inventions nonelected with traverse. These claims 1-38 and 40-49, 51-59, 61-73 were included in the rejection by mistake, and that the species in those claims were not

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searched. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Chu et al. (US 5,817,667), see column 5, lines 1-end.

Chu discloses the claimed compound of claim 60 (the elected compound) which encompasses claim 39. The other compounds which read on claim 39 are withdrawn from further consideration by the examiner. The claimed compound is taught by Chu. Since one of ordinary skill in the art could have immediately envisioned the members of the Markush group of the compound to arrive at the claimed compound, claim 60 compound. What applicant is claiming differs from what is taught by Chu by only just a double bond.

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Applicant suggests that the examiner didn't point out in the reference where the claimed compound was but since the reference clearly showed chemical structures which read right on the elected core structure, it was apparent which structure the examiner was referring to. Here applicant is reminded that the teaching in Chu is on column 5, lines 1-end.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

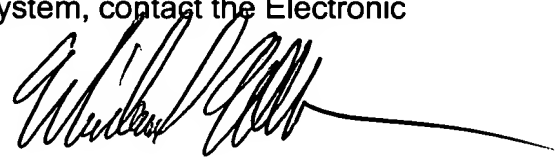
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-

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0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Michael V. Meller', with a long horizontal line extending to the right.

Michael V. Meller
Primary Examiner
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MVM